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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,086	01/10/2001	Richard L. Sandt	AVERP2822US	7421

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EXAMINER	
GREEN, BRIAN	
ART UNIT	PAPER NUMBER
3611	

DATE MAILED: 12/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/758,086	SANDT ET AL.	
	Examiner	Art Unit	
	Brian K. Green	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 October 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) *14-18 and 31-40* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 19-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4,5,6,9* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed April 2, 2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Copies of patent applications 09/167,087 and 09/758,092 have not been received.

Drawings

The drawings are objected to because in figures 7a,7b,8a, and 9a the separated parts must be embraced by a bracket. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the radio frequency identification device and the tie layers defined in claims 10 and 19 must be shown in the elected embodiment figures or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because on line 4, the word "invention" is used which is improper. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

Claims 1-13 and 19-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 8, there is no antecedent basis for "the heat-activatable of the laminate" and the phrase is awkward and confusing. In claim 20, line 5, there is no antecedent basis for "said laminating adhesive layer". Claim 23 is confusing since the applicant discloses in the specification that the face stock can be made of thermoplastic film and not the heat-activatable adhesive.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,228,486. Although the conflicting claims are not identical, they are not patentably distinct from each other because

claims 1-23 of Patent No. 6,228,486 disclose a facestock, a heat-activatable adhesive, a laminating adhesive, and a carrier layer.

Claims 20-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 6,461,722. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-38 of Patent No. 6,461,722 disclose a facestock, a heat-activatable adhesive, a laminating adhesive, and a carrier layer.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20,21,23,28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Beinert et al. (U.S. Patent No. 5,595,810).

Beinert et al. Shows in figure 1a a facestock (plastic film), heat-activatable layer (melt adhesive layer) adhered to the "lower" surface of the facestock, a laminating adhesive (adhesive layer) overlying the facestock, and a carrier layer (separation paper) adhered to the laminating adhesive. The separation paper is considered to be the top layer in the Beinert et al. patent and the carrier layer is considered to be the bottom layer. In regard to claim 23, the heat-activatable layer of Beinert et al. is a heat-activatable adhesive. In regard to claim 28, Beinert et al. shows in figure 1a that the layer of ink or graphics (Decorative layer) is on the lower surface of the heat-

activatable layer. In regard to claim 29, as broadly defined, the "Decorative Layer" of Beinert et al. is considered to be the "detack layer".

> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 20-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Kittel et al. (U.S. Patent No. 6,228,486).

Kittel et al. shows in figures 2-6 a facestock (112), heat-activatable layer (118) adhered to the lower surface of the facestock, a laminating adhesive (150) overlying the facestock, and a carrier layer (160) adhered to the laminating adhesive. In regard to claim 22, Kittel '486 discloses in column 3, lines 40-45 the idea of making the facestock out of multiple layers. In regard to claim 23, the heat-activatable layer of Kittel et al. is a heat-activatable adhesive. In regard to claims 24-27, Kittel et al. discloses the idea of making the layers out of the materials claimed by the applicant.

Claims 20-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Kittel et al. (U.S. Patent No. 6,461,722).

Kittel et al. shows in figures 2-6 a facestock (112), heat-activatable layer (118) adhered to the lower surface of the facestock, a laminating adhesive (150) overlying the facestock, and a carrier layer (160) adhered to the laminating adhesive. In regard to claim 22, Kittel '722 discloses in

column 3, lines 40-45 the idea of making the facestock out of multiple layers. In regard to claim 23, the heat-activatable layer of Kittel et al. is a heat-activatable adhesive. In regard to claims 24-27, Kittel et al. discloses the idea of making the layers out of the materials claimed by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 22 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beinert et al. (U.S. Patent No. 5,595,810).

In regard to claim 22, Beinert discloses the idea of making the facestock (plastic film) out of one thick layer. Beinert does not disclose the idea of making the facestock out of two layers. It would have been an obvious matter of design choice to make the facestock out of two layers instead of one since the applicant failed to define any advantage to making the facestock out of two layers and making the facestock out of a single layer as taught by Benert would work equally well. In regard to claims 24-27, Beinert does not disclose the use of the specific materials disclosed in these claims. However, the materials defined are conventional and it would have been an obvious matter of design choice to make the layers out of the materials defined since the applicant failed to define any advantage to making the materials out of the materials defined and the materials used by Beinert would work equally well.

Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 2-13,19, and 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3597 for regular communications and (703) 305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-2168.

Brian K Green

BRIAN K. GREEN
PRIMARY EXAMINER

bkg
December 23, 2002